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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,554	09/27/2001	Koichiro Nakamura	2001_1477A	8898

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/963,554

Applicant(s)

NAKAMURA ET AL

Examiner

Michael J Feely

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,4,6,7: 102(e) over Fehn et al.; 8-13: 103(a) over Fehn et al. in view of Suzuki et al.

Claim(s) withdrawn from consideration: _____.

8. ☒ The proposed drawing correction filed on 24 January 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 3.

Applicant's reply has overcome the following rejection(s): The 103 portion of the "102 or 103" rejection of claims 1,3,4,6, and 7 over Fehn et al. (US Pat. No. 6,187,890) has been overcome. Previously rejected claims 2 and 5 have been cancelled.

Continuation of 5.

The previous version of claims featured an adhesive composition comprising components (A), (B), (C), and (D), wherein (D) was at least one selected from (D-1) or (D-2). The embodiment featuring (D-1) was anticipated by Fehn et al. (US Pat. No. 6,187,890), and the embodiment featuring (D-2) was an obvious variation of Fehn et al.

The instant version of the claims no longer provides an option for component (D). Component (D) is now only the component that was previously designated as (D-1). The component previously designated as (D-2) is no longer present in the claims. Because of this change, the rejection is now simply a 102(e) rejection.

The instant version of claim 1 also includes limitations that were previously set forth in claim 2, which is now cancelled. Fehn et al. anticipate these limitations (note the previous rejection of claim 2). Fehn et al. also meet the limitations of claims 3, 4, 6, and 7. Therefore, the previous rejection of claims 1, 3, 4, 6, and 7 under 102(e) or 103(a) has been reduced to a rejection under 102(e) alone.

Claims 8-13 remain rejected over Fehn et al. and Suzuki et al. for the reasons of record.

Comments regarding Applicants' Remarks:

1) Concentration of component (D) – Applicants argue that only a broad disclosure of Fehn et al. overlaps the claimed concentration range of component (D), and that the most preferred embodiment of Fehn et al. does not overlap the claimed range of 0.1 to 40 wt%. However, it has been found that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments – see MPEP 2123.

2) Declaration under 37 CFR 1.132 – Applicants cite Comparative Examples B, C, D, E, F, and G; however, these examples are not mentioned in the Declaration filed January 24, 2003. The basis of Applicants' argument is unclear. Furthermore, claims 1, 3, 4, 6, and 7 are rejected under 35 USC 102(e). A declaration under 37 CFR 1.132 cannot be used to overcome an anticipation rejection.



Robert Dawson
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